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Laurie Allen

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EXAMINER

HAMMOND III, THOMAS M

ART UNIT

PAPER NUMBER

3695

NOTIFICATION DATE

DELIVERY MODE

04/13/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/608,764	<b>Applicant(s)</b> ALLEN ET AL.	
	<b>Examiner</b> THOMAS M. HAMMOND III	<b>Art Unit</b> 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

*Status of Claims*

1. This action is in reply to Applicant's response filed on 06 January 2009.
2. Claims 1, 6, and 11-12 have been amended.
3. Claims 1-14 are currently pending and have been examined.

***Response to Arguments*****101 Rejections**

4. With regard to the current rejections of claims 11-12, the Applicant has attempted to amend the claimed invention. While the Examiner appreciates the Applicant's attempt to remedy such deficiencies, the Examiner asserts that such rejections have not been overcome. Claim 11, as recited by the Applicant, is directed toward a system for providing an on-line travel expense report. However, the only possible tangible piece of the system is directed toward a computer program product. Indeed, the Applicant claimed invention is directed toward 2 separate statutory categories. As such, it is unclear what the Applicant is intending to encompass. Since all of the limitations are directed toward the computer program product, the Examiner suggests the preamble be changed to *A computer readable medium, tangibly embodied with instructions which, when executed by a computer, perform the steps comprising:...* Claim 12, as recited by the Applicant, is directed similarly to claim 11. Moreover, if system claims are sought by the Applicant, the Applicant must recite the physical components of the system (i.e. computer, database, input device, server, monitor, processor, etc...) in order to be eligible for patent protection.

**Prior Art Rejections**

5. The Applicant's arguments are considered moot in view of the new grounds of rejection, necessitated by the Applicant's substantial amendments to the claimed invention.

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***Previous Claim Rejections - 35 USC § 101***

6. Claims 11-12 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. Such rejections remain, as described below.

7. The claims, as recited are directed toward a system for performing the method of the Applicant's invention. However, such claims continue to reflect only intangible limitations. It is also unclear whether the Applicant is seeking protection on a system or a computer program product, in light of the amendments. Although the Examiner appreciates the Applicant's attempt to cure these deficiencies under the guidelines of US Patent 5710578, the Examiner asserts that the claims remain deficient. In order to claim a system, the Applicant must identify the tangible, functional components of the system. Since computer useable medium has not been defined in the specification, it can be interpreted to encompass signals, carrier waves, and the like. Such abstract ideas are not eligible for patent protection. In the instant application, the structural limitations of an input device, a processor, a terminal, a database, and a network, if added to the body of the claim, would be sufficient to define the system. On the contrary, if the computer program product is sought, the program must be tangibly embodied on a computer readable medium and executable on a computer to perform the steps of the invention.

***New Claim Rejections - 35 USC § 101***

8. Claims 1-10 and 13-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

*"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.');* *Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' ');* *Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.')*<sup>7</sup> *A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article."* (In re Bilski, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

9. Also noted in *Bilski* is the statement, “Process claim that recites fundamental principle, and that otherwise fails ‘machine-or-transformation’ test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’” (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO’s “Guidance for Examining Process Claims in view of *In re Bilski*” memorandum dated January 7, 2009, [http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski\\_guidance\\_memo.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf).

10. It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>.

11. Claims 1-10 and 13-14 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 1-10 and 13-14 are non-statutory under § 101.

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***Previous Claim Rejections - 35 USC § 112***

12. Claim 1 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner appreciates the Applicant's prompt attention to this deficiency and hereby withdraws such rejection.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

14. Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Shoolery et al.*, US Patent No. 5,570,283, in view of, *Buchanan*, US Patent No. 6,009,408, in further view of *Wu et al.*, US Patent No. 6,959,339.

**As per claim 1*****Shoolery teaches:***

- Receiving, at a transaction processor host, a request for the travel expense report, wherein the request includes data selection criteria comprising a corporate transaction account provider identifier, an air sector, and a fare basis code (see at least column 5, lines 13-64)
- Parsing the request to retrieve the data selection criteria from the natural language query if the request includes the natural language query (see at least column 7, lines 1-36)
- Receiving a categorized view instruction, wherein the categorized view instruction determines a data placement and format for the processed travel expense report (see at least column 7, lines 21-36)
- Formatting the data selection criteria in accordance with format requirements of a plurality of disparate travel sources, wherein the plurality of disparate travel sources comprise at least one of: a Customer Reservation System (CRS) and an air carrier which store travel transaction data including travel cost data (see at least column 4, lines 25-45)
- Retrieving the travel transaction data from at least one of the plurality of disparate travel sources in accordance with the data selection criteria, wherein the travel transaction data includes the travel cost data, the air sectors, and the fare basis codes provided by the air carrier, wherein the travel transaction data is



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obtained by the transaction processor (see at least column 7, lines 37-67; column 8, lines 1-4; column 5, lines 13-42)

- Adding proprietary information to the financial transaction account data and the travel transaction data, wherein the proprietary information relates to a host supplier network (see at least column 4, lines 46-65)
- Adding to the travel expense report, line item detail from the travel transaction data (see at least column 8, lines 32-49)
- Positioning each of the data elements according to the relationships and in accordance with the categorized view instruction, wherein the data elements are marked as billed or unbilled (see at least column 8, lines 32-49)
- Conditioning the data elements to create the processed travel expense report for transmission to a client, the transaction and sending the processed financial data travel expense report to a client, wherein the client analyses the data travel expense report to determine a level of spend for a defined item over a defined time (see at least column 4, paragraphs 8-25)

***Shoolery does not teach:***

- Formatting the data selection criteria in accordance with format requirements of each of a plurality of disparate financial sources, wherein the plurality of disparate financial sources comprise financial account providers which store financial transaction account data including financial charge data
- Retrieving the financial transaction account data, including the financial charge data, from at least one of the plurality of disparate financial sources in accordance with the data selection criteria
- Adding to the travel expense report, line item detail including the financial charge data from the financial transaction data
- Receiving both travel cost data from travel sources and financial charge data from financial account sources based on a single natural language query which analyzes metadata associated with the request and processes the request based on instruction protocols contained in the metadata

***Buchanan teaches:***

- Formatting the data selection criteria in accordance with format requirements of each of a plurality of disparate financial sources, wherein the plurality of disparate financial sources comprise financial account

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providers which store financial transaction account data including financial charge data (see at least column 3, lines 40-57; column 11, lines 1-63)

- Retrieving the financial transaction account data, including the financial charge data, from at least one of the plurality of disparate financial sources in accordance with the data selection criteria (see at least column 3, lines 40-57; column 11, lines 1-63)
- Adding to the travel expense report, line item detail including the financial charge data from the financial transaction data (see at least column 3, lines 40-57; column 11, lines 1-63)

***Wu teaches:***

- Receiving data from multiple, disparate sources based on a single natural language query which analyzes metadata associated with the request and processes the request based on instruction protocols contained in the metadata (see at least column 10, line 40 - column 11, line 7, column 12, lines 20-34)

*However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the financial account retrieval and formatting functions of Buchanan and the natural language query processing of Wu to the teachings of Shoolery. One would have been motivated to do so in order to provide better management of travel expenses in a corporate environment (see at least Shoolery column 8, lines 27-31). Moreover, the Applicant has combined three well known methods to produce a product that functions as a travel expense management system comprising retrieving travel cost information and retrieving financial information using a natural language query and formatting the information suitable to a user. As shown above, these three main ideas are well known according to Shoolery, Buchanan, and Wu. Merely combining these well known methods into a single product does not render the invention patentably distinct from the prior art combination of these well known methods.*

**As per claim 2**

***Shoolery, in view of Buchanan and Wu, teaches the method of claim 1, as described above.***

***Shoolery further teaches:***

- The conditioning step includes converting the data elements from at least one of: the disparate travel sources or the disparate financial sources into a single format (see at least column 4, lines 46-65)

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**As per claim 3**

*Shoolery, in view of Buchanan and Wu, teaches the method of claim 2, as described above.*

*Shoolery further teaches:*

- Formatting the processed financial transaction account data into a report (see at least column 4, lines 46-65; column 8, lines 32-49)

**As per claim 4**

*Shoolery, in view of Buchanan and Wu, teaches the method of claim 3, as described above.*

*Shoolery further teaches:*

- Receiving a query associated with the request (see at least column 4, lines 46-65)
- Processing the financial transaction account data and the travel transaction data to extract account data satisfying parameters of the query (see at least column 5, lines 45-65)
- Sending the extracted account data to a client (see at least column 5, lines 45-65)

**As per claim 5**

*Shoolery, in view of Buchanan and Wu, teaches the method of claim 4, as described above.*

*Shoolery further teaches:*

- Formatting the extracted account data into a report (see at least column 5, lines 45-65)

**As per claim 14**

*Shoolery, in view of Buchanan and Wu, teaches the method of claim 1, as described above.*

*Shoolery further teaches:*

- Frequent flyer loyalty programs (see at least column 3, lines 7-25)

*Buchanan further teaches:*

- Applying loyalty points to the travel cost data in order to offset the financial charge data in an amount equal to a value of said loyalty points (see at least column 5, line 55 – column 6, line 4)

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## **ADDITIONAL REJECTIONS**

### **As per claims 6-12**

With regard to claims 6-12, the Examiner has interpreted them to encompass substantially the same scope of subject matter as recited in claims 1-5 and 13-14. Accordingly, claims 6-12 are rejected in substantially the same manner as claims 1-5 and 13-14.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Shoolery*, in view of, *Buchanan and Wu*, in further view of, *OFFICIAL NOTICE*.

### **As per claim 13**

*Shoolery, in view of Buchanan and Wu, teaches the method of claim 1, as described above.*

*Shoolery, Buchanan, and Wu do not teach:*

- Wherein the disparate financial sources include regional providers of the corporate transaction account that operate as at least one of: a wholly owned organization, a franchise, and a partnership

*However, the Examiner has previously taken OFFICIAL NOTICE that these types of businesses are old and well known in the art and are merely non-functional descriptions of the preferred embodiment of the Applicant's invention. The Examiner further asserts that the Applicant has not properly challenged such statement of OFFICIAL NOTICE, therefore rendering such statement prior art of record, henceforth.*

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Hammond III whose telephone number is 571-270-1829. The examiner can normally be reached on Monday - Friday, 7AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas M Hammond III  
Patent Examiner, Art Unit 3695  
US Patent & Trademark Office  
07 April 2009

/Thu Thao Havan/  
Primary Examiner, Art Unit 3695